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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,470	05/24/2000	Toshikazu Hamamoto	JG-YY-4971	5385

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REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

ALEJANDRO, RAYMOND

ART UNIT	PAPER NUMBER
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1745

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DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/577,470

Applicant(s)

HAMAMOTO ET AL.

Examiner

Raymond Alejandro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15 and 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 12/16/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/577470 is acceptable and a CPA has been established. An action on the CPA follows.

This communication is responsive to the foregoing CPA. The applicants have overcome most of the objections and the 35 USC 112 rejection. However, the claims are newly-finally rejected over the art as seen below. Thus, this action is made final.

Claim Objections

2. Claims 1 and 15 are objected to because of the following informalities: both claims recite twice (two times) the limitation "a sulfone compound", thus, it is redundant. Appropriate correction is required.

Specification

3. The amendment filed 06/07/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: (claims 1 and 15) the specific organic compound "propargyl carbonate". It is noted that the specification discloses the use of the organic compound "methyl propargyl carbonate" (page 4, line 35-36 and Table 1) but not the use of "propargyl carbonate". If applicants further contend that the foregoing organic compound(s) are(is) the same, please provide evidence to demonstrate it.

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Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2-15 and 17-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows: (claims 1 and 15) the specific organic compound “propargyl carbonate”. It is noted that the specification discloses the use of the organic compound “methyl propargyl carbonate” (page 4, line 35-36 and Table 1) but not the use of “propargyl carbonate”. If applicants further contend that the foregoing organic compound(s) are(is) the same, please provide evidence to demonstrate it.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 3-6, 11-15, 17-20 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Negoro et al 6156459 in view of Yamaura 5989744.

The instant application is directed to a non-aqueous electrolytic solution wherein the disclosed inventive concept comprises the specific combination of organic compounds and solvents. Other limitations include the weight percent, the reduction potential, the specific organic compounds and solvents and its volume percent.

Negoro et al disclose a non-aqueous electrolytic solution secondary battery that comprises a negative electrode material, a positive electrode material, and a non-aqueous electrolytic solution containing a lithium salt, wherein the battery contains an organoboron compound (abstract). *The organoboron compound may be contained in the electrolytic solution* (col 24, lines 20-23); when contained therein, the content of the compound is preferably from 0.0001 to 0.1 mol/l, further the content of the compound in the electrolytic solution is preferably from 0.001 to 10 weight %, and more preferably from 0.01 to 5 weight % (col 24, lines 27-34).

It is disclosed that the electrolytic solution is generally composed of a solvent and a supporting electrolyte dissolvable in the solvent (col 24, lines 35-58). Examples of solvents include propylene carbonate, ethylene carbonate, butylene carbonate, dimethyl carbonate, diethyl carbonate and methyl ethyl carbonate, 1,3-propanesultone and the like, which may be used alone or as a mixture of two or more. Preferably are those including cyclic carbonates and/or acyclic carbonates (col 24, lines 35-58). *In particular, the use of mixed solvent of propylene carbonate or ethylene carbonate and/or diethyl carbonate is preferable* (col 25, lines 10-21/ claim 5). The example for preparation of electrolytic solutions shows the use of 65.3 g of diethyl carbonate (chain carbonate) and 22.2 g of ethylene carbonate (cyclic carbonate), which is equivalent to approximately 25.4 weight % for ethylene carbonate, and 74.6 weight % for diethyl carbonate. Volumes percent can be then obtained by using each material density at defined conditions. In

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addition, the reduction potential is an implicit teaching based on the property of each different compound which is taught.

Negoro et al further teach that the negative electrode material is a carbonaceous material including natural graphite or artificial graphite (col 25, lines 40-50). It is also disclosed that, preferably, the average particle size is 0.1 to 60 μm (col 29, lines 42-46). A preferable positive electrode material is a lithium containing transition metal oxide (col 29, lines 59-64).

Negoro et al disclose nonaqueous electrolytic solution according to the foregoing. However, Negoro et al do not teach the organic compound being vinylene carbonate; and do not explicitly disclose the combination of two organic compounds with two solvents, and the particularity of the graphite material.

Yamaura discloses that as for the non-aqueous electrolytic solution for constituting the secondary cell it is possible to use a non-aqueous electrolyte dissolved or dispersed in a conventional non-aqueous medium such as vinylene carbonate; and the non-aqueous solvent may be made from a single carbonate or a mixture of more than one carbonates (col 6, line 58 to col 7, line 7).

Thus, it would have been obvious to one skilled in the art at the time the invention was made to use vinylene carbonate as a compound in Negoro et al's non aqueous electrolytic solution as Yamaura teaches that, judging from voltage stability, it is preferable to use chain carbonates as vinylene carbonate. Moreover, the non-aqueous solvent may be made from a single carbonate or a mixture of more than one carbonates. Thus, the use of vinylene carbonate as a compound in a non-aqueous electrolytic solution is suitable and chemically compatible with Negoro et al' electrolytic system.

Additionally, it would have been obvious to one skilled in the art at the time the invention was made to make the non-aqueous electrolytic solution having at least two organic compounds as Negoro et al teach that the solvents may be used alone or as *mixture of two or more*. Therefore, by providing a multiple combination of solvents as taught the prior art, at least three solvents (different compounds) would be present in the non-aqueous electrolytic, and one of the three solvents would then become in the second organic compound. Furthermore, the use of these multiple compounds, regardless whether or not they are solvents, is a generally acceptable practice in the art because it provides to the electrolytic solution the dissolvable feature which is required for supporting the compounds, electrolyte and materials therein. In addition, the reduction potential is an implicit teaching based on the property of each different compound which is taught.

With respect to the graphite material, it would be obvious to recognize that Negoro et al's anode material may possess the specific lattice spacing as Negoro et al's anode material is either natural or artificial graphite, and thus, this material does have a graphite type crystal structure capable of intercalation and deintercalation of lithium. Hence, Negoro et al's negative electrode material is a carbonaceous material that is capable of occluding and releasing lithium.

7. Claims 8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Negoro et al 6156459 in view of Yamaura 5989744 as applied to claims 1 and 15 above, and further in view of Tamura et al 5342711.

Negoro et al and Yamaura are applied and incorporated herein for the reasons above. In addition, Negoro et al and Yamaura do not disclose the organic compound being a sulfonate.

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Tamura et al disclose a battery with a nonaqueous electrolyte comprising a compound selected from the group consisting of lithium trifluoromethanesulfonate among them, which is dissolved in a solvent mixture comprising ethylene carbonate and an ethereal solvent (abstract).

Based on the aforementioned, it would have been obvious to a skilled artisan in the art to use an organic sulfonate compound in the electrolytic solution of Negoro et al and Yamaura as Tamura et al teach that by combining an electrolyte comprising a combination of an electrolyte of an organic sulfonate (lithium trifluoromethanesulfonate), a higher stability with a solvent mixture and a lower viscosity in particular volume ratio is obtained. Additionally, the electrochemical cell exhibits a lower utilization, after the initiation of the discharge and charge cycles. That is, the utilization at a particular point of time of the completion of specific cycles is inferior to the utilization of the prior art's batteries. Further, the Coulombic efficiency shows an improved long life cycling property.

Allowable Subject Matter

8. The following is a statement of reasons for the indication of allowable subject matter: the allowable subject matter was set forth in a prior office action, refer to paper # 3.

***** It is noted that the specific allowable subject matter as previously indicated refers to the particular combination of organic compounds as recited either in claim 7, 9-10, 21, or 23-24. *****

9. Claims 7, 9-10, 21, and 23-24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Moreover, with respect to applicants' arguments regarding to the experimental showing provided in the present application, it is asserted that the although the results derived therefrom appears to show some improvement in discharge capacity retention, they are not commensurate to the specific limitation of the instant claims. For example, the instant claims lack the particular a) solvent system including constituents and its content (weight or mass percent), and b) the specific additives (organic compounds) and its content therein. Accordingly, the singular results do not represent or stand for the chemical system of the present invention.

11. Further, applicant's experimental results only show how a mixture of VC and PS is better than either one of these alone.

Conclusion

12. This is a CPA of applicant's earlier Application No. 09/577470. *All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.* Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Alejandro whose telephone number is (703) 306-3326. The examiner can normally be reached on Monday-Thursday (8:30 am - 7:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary examiner, Steve Kalafut can be reached on (703) 308-2383. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Raymond Alejandro
Examiner
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STEVE KALAFUT
PRIMARY EXAMINER
GROUP 1700